

Appl. No. 09/842,148
Amdt. dated Sept. 28, 2004
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REMARKS

Claims 1-8, 10, 11 and 13-16 stand rejected under §102 as being anticipated by, or in the alternative, under §103 as being obvious from Cohen (U.S. Patent No. 5,156,148). Claim 9 stands rejected as being obvious from Cohen. The application of Cohen is the same for independent claim 1.

As noted in the office action, Applicant's previous argument has been that claim 1 specifies a processor that determines whether an arrhythmia is atrial or ventricular as a function of only the sensed cardiac electrical signals. Drug delivery is activated based upon a determination that the arrhythmia is atrial or ventricular. Cohen is distinguished on the basis that it discloses a system for the treatment of cardiac arrhythmias which is not a "rate-only" system to detect and identify an arrhythmia. As pointed out, Cohen considers "rate-only" systems to inadequately differentiate between hemodynamically stable and unstable rhythms. Cohen therefore teaches to combine a physiologic parameter indicative of the hemodynamic condition of the patient with an electrical rate signal derived from the heart (see col. 4, lines 10-15 and lines 19-26). Thus, the processor in Cohen identifies atrial and ventricular arrhythmias as a function of both a physiologic signal indicative of patient hemodynamic condition and a cardiac electrical signal (see col. 4, line 67 to col. 5, line 13) and bases drug delivery thereon. This is clearly depicted in Fig. 1 and Figs. 5A-5I also.

In response to Applicant's arguments and in view of amendments made to claims 1 and 11, the office action now argues, at page 6, a different position in order to dismiss the distinction of the claimed invention over Cohen. The office action now argues that, because a reference may be relied upon for all that would have been reasonably suggested to one having ordinary skill in the art, the disclosure in Cohen can be dissected to exclude consideration of the express requirement of detection of a patient's hemodynamic condition. The office action cites to MPEP 2123.

It is respectfully submitted that the position now argued in the office action ignores the express language quoted from *In re Heck* that patents are relevant "for all they contain." (emphasis added.) Also the argument relies upon caselaw involving facts

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where a disclosed, nonpreferred embodiment was the basis for the rejection. Cohen "contains" a teaching that a "rate-only" system is not workable with his proposed treatment therapy of drug delivery. The teaching in Cohen is not one of a "nonpreferred embodiment." Cohen is inapposite to the modern in *Celeritas Technologies Ltd. v. Rockwell International Corp.*, which was disclosed as workable but just not optimal. Cohen is specific that his teaching is to use a physiologic parameter that is derived from the human body and provides information as to the hemodynamic condition of the patient. See col. 4, lines 19-22. The discussion in MPEP 2123 of nonpreferred embodiments as prior art fails to provide support for the new position taken and argument being made in the office action.

Moreover, the provisions of MPEP 2123 concern the use of a prior art's broad disclosure. The broad disclosure of Cohen is that a rate-only system without regard to the patient's hemodynamic condition is not workable. Contrary to the position taken in the office action on the misplaced reliance on MPEP 2123, Cohen reasonably suggested to one skilled in the art that the detection criteria must include detection of a parameter indicative of the hemodynamic condition of the patient. The rejections based on Cohen necessarily fail under the provisions of MPEP 2123.

The office action misrepresents both MPEP 2123 and Cohen. Applicant submits that all pending claims are in condition for allowance and requests that a notice of allowance be issued in due course.

Respectfully submitted,

Date: September 28, 2004

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